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Conley Rose, P.C.
P.O. Box 684908
Austin, TX 78768-4908

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES D. HUSTON and DARRYL J. CORNISH

Appeal 2008-003792
Application 10/772,071
Technology Center 3600

Decided: October 28, 2009

Before JENNIFER D. BAHR, MICHAEL W. O'NEILL, and STEFAN STAICOVICI, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Charles D. Huston et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 21-36, 38, 39, and 41. Appellants cancelled claims 1-20, 37, and 40. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Invention

The claimed invention is to displaying advertisements to golfers on a golf course when the system determines that the golfer is at a position that has been stored within the system.

Claim 21, reproduced below, is illustrative of the subject matter on appeal.

> 21. A method for displaying an advertising message to a golfer on a golf course using a global positioning satellite system comprising the steps of:
>
> positioning a remote global positioning satellite receiver on the golf course;
>
> determining a present position of the remote receiver on the golf course using a global positioning satellite system;
>
> storing one or more advertising locations on the golf course;
>
> comparing the one or more advertising locations with the present position of the remote receiver; and
>
> displaying the advertising message to the golfer if the present position of the remote receiver is an advertising location.

The Rejections

The following Examiner's rejections are before us for review:

1. Claims 21-33, 35, 36, 38, 39 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,524,081, to Paul, issued on Jun. 4, 1996, (hereinafter "Paul") in view of U.S. Patent No. 5,326,095 to Dudley, issued on Jul. 5, 1994, (hereinafter "Dudley").

2. Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul, Dudley, and WO 88/00487 to Bonito et al., published on Jan. 28, 1988, (hereinafter "Bonito").

3. Claims 21-36, 38, 39 and 41 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-26 in U.S. Pat. No. 5,364,093 to Huston issued on Nov. 15, 1994, in view of Paul or Dudley.

SUMMARY OF DECISION

We AFFIRM.

OPINION

Issues

The dispositive issue on appeal with respect to the obviousness rejections, developed from the contentions of the Appellants and the position and responses of the Examiner, is whether it would have been obvious to add to Paul the feature of displaying advertisements.

The other issue on appeal with respect to the non-statutory obviousness-type double patenting rejection is whether the Appellants have demonstrated that the Examiner erred in making this rejection.

Principles of Law

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007). In particular, the Supreme Court emphasized that "the principles laid down in

Graham reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 550 U.S. at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR,* 550 U.S. at 416. The Court explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 550 U.S. at 417. Accordingly, the operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The Federal Circuit recently concluded that it would have been obvious to combine (1) a mechanical device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) an electronic, processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) ("[a]ccommodating a prior art mechanical device that accomplishes [a desired] goal to modern electronics would have been reasonably obvious to one of ordinary skill in

designing children's learning devices."). In reaching that conclusion, the Federal Circuit recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Id.* at 1161 (citing *KSR*, 550 U.S. at 416 ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.")). The Federal Circuit relied in part on the fact that *Leapfrog* had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog*, 485 F.3d. at 1162 (citing *KSR*, 550 U.S. at 418).

The issue to consider when determining whether a nonstatutory basis exists for a double patenting rejection is whether any claim in the application defines an invention that is merely an obvious variation of an invention claimed in another patent. The analysis employed in an obviousness-type double patenting determination parallels the guidelines for an obviousness determination under 35 U.S.C. § 103(a). *See In re Braat,* 937 F.2d 589, 593-94 (Fed. Cir. 1991); *see also In re Longi,* 759 F.2d 887, 892 n. 4 (Fed. Cir. 1985).

Analysis

Obviousness rejections based on Paul and Dudley

We agree with the Examiner's findings of facts and the legal conclusion of obviousness with the combination of Paul and Dudley, as well as the Examiner's responses to the Appellants' arguments against the

rejections of claims 21, 32, 34, and 41 in the Appeal Brief. We add the following primarily for emphasis.

Dudley teaches that it was well known in the golf art to display advertising messages to a golfer regardless of whether the golfer, while using the golf cart having the system, is paying for using the golf information system. Col. 7, ll. 18-20.

Paul discloses a golf information and course management system. Paul, *passim*. Paul discloses that a golf cart receives GPS signals from orbiting satellites, processes the signals with the computer on the golf cart, and outputs to a display the position of the golf cart on the golf hole being played by the golfer. *Id.*, col. 5, l. 65 to col. 6, l. 11 and fig. 2.

Paul briefly explains how the position of any mobile unit, in this case a golf cart, is determined. In summary, a GPS or DGPS system that is located on a mobile unit solves four simultaneous equations that are well known to persons skilled in the art. The solution is the location of the unit. *Id.*, col. 6, ll. 20-60.

Paul discloses that the computer on the golf cart is pre-loaded with a map of each golf hole. Paul's Figure 4 shows the graphic display on the golf cart. The display provides basic golf information such as par for the golf hole, the distance from the golf tees to the golf hole, the handicap for the golf hole, and any golf hazards (sand traps, water, etc.), which are highlighted when in play as compared to non-play golf hazards. Additionally, the golfer's position is highlighted on the graphical hole layout on the display. Based on the golfer's position, the computer will calculate the distance to the golf hole, the distance to the hazards in play, and other critical information for the golfer. Further, based on the golfer's position,

the computer will retrieve stored golf pro notes that provide strategy based on the current golf ball position (the lie) and other elements of the golfer's play. The golf pro's strategy can be provided to the golfer in the form of a video presentation that provides a friendlier version of the golf pro's advice and tips for playing the golf hole at the golfer's (golf cart's) current position on that golf hole. *Id.*, col. 6, l. 61 to col. 7, l. 13. Further, Paul discloses broadcasting advertising notices from the base unit to all carts, or any specific cart. *See e.g.*, *id.*, col. 8, ll. 15-20.

Accordingly, Paul discloses golf carts having computers that receive GPS signals in order to determine the position of the golf carts on the golf course. Once the position of the golf cart is determined the computer provides information stored therein to the golfer via the display. The information presented to the golfer is information to assist the golfer's play at that particular location, and to provide the golfer with a golf pro's strategy in the form of a video presentation containing advice and tips for playing the golf hole at the golfer's (golf cart's) current position on that golf hole.

Comparing Paul's disclosure to the method steps within claim 21, Paul's disclosure of a golf cart positioned on a golf hole satisfies the step of "positioning a remote global positioning satellite receiver on ... [a] golf course" because Paul's disclosed golf cart contains a computer that receives GPS signals. Paul's disclosure of calculating the position of the golf cart on the golf hole based on the received GPS signals satisfies the step of "determining [the] present position of the remote receiver on the golf course using a global positioning satellite system." Paul's disclosure of the computer on the golf cart being pre-loaded with a map of each golf hole demonstrates that Paul's golf cart computer stores one or more locations

regarding a golf course in a memory. Paul's disclosure of the golf cart computer providing to the golfer a variety of golf information to assist the golfer's play at that particular location demonstrates that Paul's golf cart computer compares locations stored in the computer with the present position of the golf cart. Paul's disclosure of providing the golfer a golf pro's strategy in the form of a video presentation demonstrates that Paul's golf cart computer displays messages to the golfer when the golf cart computer is at a particular location stored within the memory of the golf cart computer. As such, Paul's disclosure explicitly satisfies certain steps of claim 21 and demonstrates that Paul's golf cart computer stores locations of the golf course, compares locations with the present position of the remote receiver, *viz.* the golf cart, and displays a message to the golfer when the present position of the remote receiver is at a particular location.

The difference between Paul's disclosure and the invention within claim 21 is the improvement of storing locations that would prompt Paul's golf cart computer to display advertising messages when the golf cart was at a location for advertisements. In other words, what is absent from Paul is Paul's computer memory storing locations, and advertisements that Paul's computer sends to the display when Paul's golf cart reaches such a location. Paul discloses a processor, a memory, and a display; however, Paul does not disclose this processor, memory, and display providing advertising information to the golfer when the golfer's present position is a stored position in the memory of Paul's golf information system. Instead, Paul discloses a video presentation of a pro golfer's advice and tips is provided at that position.

As stated above, Dudley teaches displaying advertisements to a golfer regardless of whether the golfer is paying for the service. Additionally, Dudley teaches that information is gathered and displayed at discrete locations on a golf hole. For instance, as shown in Dudley's figures 1 and 8, a golf hole is divided into a number of regions or zones over which particular information is relevant. *See* Dudley, col. 4, ll. 18-20 and col. 8, ll. 27-58. Dudley teaches that once a golf cart enters a region or a zone, and remains for a particular period of time, information relevant to that region is displayed to the golfer. *Id.*, col. 6, l. 21 to col. 7, l. 3. Accordingly, Dudley teaches information, and such information includes advertisements, displayed at particular locations on a golf hole.

Since Paul's golf cart computer is capable of displaying particular messages to a golfer that are stored in the computer when the present position of the golf cart is at a stored position within the computer, Paul's golf cart computer is readily capable of the improvement of displaying advertising messages at discrete locations based on the teachings of Dudley. A person of ordinary skill in the art would readily understand that the addition of Dudley's advertisements and providing information, which would include advertisements, at discrete locations on a golf hole, is merely an improvement to the similar golf information and management device disclosed in Paul. Further, Appellants have not presented evidence that the inclusion of advertisements into Paul's golf computer would be "uniquely challenging or difficult for one of ordinary skill in the art." *Leapfrog*, 485 F.3d at 1162. Instead, Appellants contend that: combining Paul and Dudley would change the operating principles of both Paul and Dudley; no reason for the combination is explicit in the record; and the combination of Paul and

Dudley does not meet the claim limitations. We will address these contentions *infra* after addressing the other independent claims 32 and 41 that are on appeal.

Claim 32 claims the Appellants' invention as an apparatus for displaying advertising messages. Our reasoning *supra* with respect to why there is no error found with respect to the Examiner's rejection of claim 21 applies equally to claim 32.

Claim 41 adds to the method of displaying advertising information the additional step of correcting the position of the remote receiver. As the Examiner found, Paul uses differential correction from the golf cart computer to determine the position. *See* Ans. 3-4 and Paul, col. 6, ll. 4-11. Accordingly, Paul discloses the step of correcting the present position of the remote receiver.

Addressing Appellants' contentions, as we have discussed *supra*, the combination of Paul and Dudley meets the claim limitations. The Examiner has not proposed bodily incorporation of the features of Dudley into Paul, and obviousness does not require that one reference needs to be bodily incorporated into another, as the Appellants imply with their argument that the operating principles of the references would be changed if combined, as well as their reliance on *Ratti*. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference...." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). *See also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) ("Combining the *teachings* of

references does not involve an ability to combine their specific structures."). As stated in *KSR*, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR*, 550 U.S. at 417. We do not find that the manner the Examiner has proposed to combine Dudley with Paul (simply adding advertising messages to Paul's memory and thus improving a device in the same way as taught by a similar device) would change the operating principle of either reference. Therefore, the Appellants' contentions that the claim limitations are not met and the combination would change the operating principles of Paul and Dudley are not persuasive.

Appellants' contention that there is no reason in the record to combine Paul and Dudley is without merit. The Examiner has provided ample reasons to combine; e.g., "generating additional monetary gains." Ans. 5.

Inasmuch as Appellants do not separately argue claims 22-31, 33, 35, 36, 38, and 39, claims 22-31 fall with claim 21 and claims 33, 35, 36, 38, and 39 fall with claim 32 for the given reasons *supra*.

Obviousness rejection based on Paul, Dudley, and Bonito

Appellants rely on the arguments against the rejection of claim 32 for the rejection of claim 34. App. Br. 9. Appellants have not demonstrated error in the rejection of claim 32, and as such, have not demonstrated error with respect to the rejection of claim 34.

Obviousness-type double patenting rejection based on Huston '093 and Paul or Dudley

Appellants appear to contend that since an Office action in the Huston '093 patent did not afford the claims under examination at that time the

filing date of the Huston '093 patent application, this evidences that the Examiner erred in making the obviousness-type double patenting rejection with the combination of Huston '093, Paul, and Dudley. App. Br. 10. Additionally, Appellants' contend that they cannot find a single claim in the Huston '093 patent that would render claims 21-36, 38, 39, and 41 obvious. *Id.* Further, Appellants contend that there is no motivation to combine Paul or Dudley with the claims of the Huston '093 patent. *Id.* Appellants do not separately argue claims 21-36, 38, 39, and 41 for this ground of rejection. We select claim 32 as representative of the group. Accordingly, claims 21-31, 33-36, 38, 39, and 41 stand or fall with claim 32.

The Examiner found that the limitations within claim 15 of the Huston '093 patent disclose the apparatus of claim 32 except for showing "advertising information associated with advertising locations stored in the member and the comparison of the present position of the receiver with the stored advertising information locations." Ans. 9. The Examiner then found that Paul or Dudley teach what is lacking within claim 15 of the Huston '093 patent. Ans. 9-10. Then, the Examiner reasoned that to combine the teachings of Paul or Dudley with the invention of claim 15 of the Huston '093 patent would provide the predictable result of generating income. Ans. 10.

Appellants have not pointed out with any specificity any limitation of claim 32 not addressed by the Examiner. Additionally, the Examiner provided a reason to combine Paul or Dudley with the invention of claim 15 of the Huston '093 patent. *See* Ans. 10.

CONCLUSIONS

Paul is capable of having the added feature of displaying advertisements.

The Appellants have not demonstrated that the Examiner erred in rejecting claims 21-36, 38, 39, and 41 under the non-statutory ground of obviousness-type double patenting.

DECISION

The Examiner's decision to reject claims 21-33, 35, 36, 38, 39 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of Dudley is affirmed.

The Examiner's decision to reject claim 34 under 35 U.S.C. § 103(a) as being unpatentable over Paul, Dudley, and Bonito is affirmed.

The Examiner's decision to reject claims 21-36, 38, 39, and 41 on the non-statutory ground of obviousness-type double patenting over claims 1-26 in the Huston '093 patent in view of Paul or Dudley is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2008-003792
Application 10/772,071

mls

CONLEY ROSE, P.C.
P.O. BOX 684908
AUSTIN, TX 78768-4908